

Attorney Docket No: 23546-07665
Client Ref: RTS-274
USSN: 10/006,191

REMARKS

STATUS OF THE CLAIMS

Claims 1-10 and 12-14 were pending in this application. Claims 1, 3, 4, 6, 8, and 10 have been amended, and claims 2 and 14 have been canceled. Following entry of the amendments claims 1, 3-10, 12, and 13 will be pending and at issue.

SUPPORT FOR AMENDMENTS TO THE CLAIMS

Claim 1 has been amended to incorporate an element of claim 2 (an antisense oligonucleotide) and claims 4, 6, and 8 ("at least one modification selected from the group consisting of ..."); the amendments to claims 4, 6, and 8 correct dependency. Claims 3 and 10 have been amended to be rewritten in independent form including all of the limitations of the base claim and any intervening claims. Support for these amendments can be found throughout the specification as filed, e.g., the claims as originally filed.

The amendments to the claims therefore add no new matter and entry is requested.

Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

ALLOWABLE SUBJECT MATTER

The Examiner stated "Claims 3-10 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims." In response, Applicant has amended claims 3 and 10 to be rewritten in independent form including all of the limitations of the base claim and any intervening claims. Rather than individually amending claims 4-9, Applicant has amended Claim 1 to include the element of claim 2 (an antisense oligonucleotide) and a Markush group that includes the elements from claims 4, 6, and 8 ("at least one modification selected from the group consisting of ... "); the remaining amendments correct dependency. Claim 14 has been canceled, as it is now duplicative of claim 12. Applicant believes these amendments place the claims in condition for allowance, and withdrawal of this objection is respectfully requested.

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REJECTIONS UNDER 35 U.S.C. § 102/103

Claims 1 and 2 were rejected under 35 U.S.C. 102(a) and (e) as allegedly anticipated by or, in the alternative, under 35 U.S.C. 103(a) as allegedly obvious over Versteeg et al (WO 01/85941). Versteeg et al discloses SEQ ID NO:313, which is complementary to nucleotides 2221-2230 of the instant target sequence SEQ ID NO:19.

Without agreeing with the Examiner's position but rather to further prosecution, Applicant has canceled claim 2, rendering moot this rejection of claim 2. Applicant has amended claim 1 to include the elements of "an antisense oligonucleotide" from claim 2 and "at least one modification selected from the group consisting of a modified internucleoside linkage, a modified sugar moiety, and a modified nucleobase" from claims 4, 6, and 8 (claims the Examiner indicated would be allowed if rewritten in independent form). Versteeg et al does not disclose an antisense oligonucleotide comprising at least one modification selected from the group consisting of a modified internucleoside linkage, a modified sugar moiety, and a modified nucleobase. Accordingly the cited reference does not include every element of amended claim 1 and does not anticipate the claim as amended. In addition, the cited reference product does not meet all the structural requirements of the product of amended claim 1, and does not render the claim obvious. Withdrawal of this rejection is respectfully requested.

REJOINDER OF CLAIMS 15-20

If product claim 1 is found allowable, Applicant respectfully reminds the Examiner that withdrawn process claims 15-20 are subject to rejoinder. Claims 15-20 were subject to restriction and depend from claim 1.

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CONCLUSION

Reconsideration of the claims is respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (415) 875-2316.

Respectfully submitted,
GAARDE ET AL

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